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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,956	11/03/2003	Michael A. McLeod	COS-926 (APIP-1125US)	5094

25264 7590 12/10/2008

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EXAMINER	
VARGOT, MATHIEU D	
ART UNIT	PAPER NUMBER
1791	

MAIL DATE	DELIVERY MODE
12/10/2008	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL A. MCLEOD
and DAVID YOUNG

Appeal 2008-5528
Application 10/699,956
Technology Center 1700

Decided: December 10, 2008

Before BRADLEY R. GARRIS, CHUNG K. PAK, and PETER F. KRATZ, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 43, 44, 51-70 and 72. We have jurisdiction pursuant to 35 U.S.C. § 6.

STATEMENT OF THE CASE

Appellants' claimed invention is directed to a method comprising casting a film on a casting roll at a line speed between 35 to 200 feet per minute and wherein the casting roll is maintained at a temperature of between about 90 to about 110 degrees Fahrenheit (Spec. ¶ 0006 and ¶ 0014). The method includes casting a film consisting essentially of a homopolymer of syndiotactic propylene (sPP) (Id.). Independent Claim 43[1] is illustrative and reproduced below:

43. A method comprising:

> casting a film consisting essentially of a homopolymer of syndiotactic propylene (sPP) at a film line speed of from about 35 to about 200 feet per minute, wherein the casting occurs on a cast roll and the cast roll is maintained at a temperature of from about 90 to about 110 degrees Fahrenheit.

The Examiner relies on the following prior art reference as evidence in rejecting the appealed claims:

Delisio	6,391,467	May 21, 2002

Claims 43, 44, 51-70, and 72 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over DeLisio.

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[1] A dependent claim that inconsistently bears the same number 43 as the independent claim 43 is also pending and appealed (Ans. 3). Our references to claim 43 are to both claims when referring to the claims subject to the Rejection before us and our disposition thereof. However, our references to claim 43 are otherwise to independent claim 43, which independent claim we select as the representative claim on which we decide this appeal as to the commonly rejected and argued claims.

SUMMARY DISPOSITION

We affirm the stated rejection for reasons set forth in the Examiner's Answer and below.

ISSUE

Have Appellants identified reversible error in the Examiner's obviousness rejection by their argument that an ordinarily skilled artisan would have no expectation that "by optimizing the parameters of lines speed and casting temperature (and using a specific defined range of each, in combination) a cast film would successfully be formed of only syndiotactic polypropylene"[2] based on the teachings of DeLisio?

RELEVANT FACTUAL FINDINGS

A preponderance of the evidence supports the following findings of fact (FF):

1. The Examiner has correctly found that DeLisio discloses or suggests a

> method for casting a film consisting essentially of a homopolymer of syndiotactic propylene (i.e., sPP – see passage bridging columns 1 and 2) at a film line speed of around 300 ft/minute (see Example 1, col. 5, line 43), wherein the casting occurs on a cast roll or drum maintained at a temperature of 100 to 110 deg[.] F (see Example 1, col. 5, line 44).

See Examiner's Answer (Ans. 4).

2. In this regard, DeLisio generally discloses cast films comprising substantially syndiotactic propylene polymer having beneficial

[2] *See* App. Br. 4.

properties can be made by known extrusion/co-extrusion processes using the "well-known chill roll cast process" (col. 1, ll. 44-64; col. 5, ll. 4-30).

3. DeLisio discloses or suggests that a single film layer of sPP can be cast (core layer) or the casting can include additional outer film layers, as correctly found by the Examiner (Ans. 4; DeLisio: Abstract; col.1, ll. 44-49; col. 2, ll. 19-21). The middle or single layer (core layer) film product of DeLisio can be a homopolymer of sPP; that is 100 percent sPP (ex. 1; col. 4, ll. 56-65).

4 Appellants acknowledge that sPP homopolymer is a commercially produced product that is known to be useful but can present some processing challenges (Spec. ¶ 0005). Appellants note that "[a] typical commercial casting system, such as that illustrated in the embodiment of Figure 1, ..." can be employed in their method (Spec. ¶ 0010). Appellants further acknowledge that processing aids that reduce melt fracture are known, which aids can be added for use in their casting method (Spec. ¶ 0012).

PRINCIPLES OF LAW

> Section 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in

the art, and (4) any evidence of secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.").

In this regard, an obviousness analysis "need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR*, 127 S.Ct. at 1741. Indeed, a conclusion of obviousness may be made "from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference." *See In re Bozek*, 416 F.2d 1385, 1390 (CCPA 1969). After all, it is well settled that "[t]he person of ordinary skill [in the art] is a hypothetical person who is presumed to [know the relevant]prior art." *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986). *See Okajima v. Bourdeau,* 261 F.3d 1350, 1355 (Fed. Cir. 2001) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.,* 775 F.2d 158, 164 (Fed. Cir. 1985) ("[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error 'where the prior art itself reflects an appropriate level and a need for testimony is not shown.'").

Also, the Supreme Court held that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR*, at 1739. *See In re Aller*, 220 F.2d 454, 456 (CCPA 1955) ("[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation."). It is well established that

consideration of a reference is not limited to working examples, but extends to the entire disclosure for what it fairly would have taught to one of ordinary skill in the art. *In re Boe*, 355 F.2d 961, 965 (CCPA 1966). Moreover, the legal conclusion of obviousness under 35 U.S.C. § 103 does not require absolute certainty, but only a reasonable expectation of success. *In re O' Farrell,* 853 F.2d 894, 903-904 (Fed. Cir. 1988).

It is axiomatic that admitted prior art in an Applicants' Specification may be used in determining the patentability of a claimed invention and that consideration of the prior art cited by the Examiner may include consideration of the admitted prior art found in an Applicants' Specification. *In re Nomiya*, 509 F.2d 566, 570-571 (CCPA 1975); *In re Davis*, 305 F.2d 501, 503 (CCPA 1962). Also, *see In re Hellsund*, 474 F.2d 1307, 1311 (CCPA 1973). Note also *In re Fout*, 675 F.2d 297, 301, (CCPA 1982), "[i]t is not unfair or contrary to the policy of the patent system that appellants' invention be judged on obviousness against their actual contribution to the art" (footnote omitted).

ANALYSIS

At the outset, we note that Appellants argue the rejected claims together as a group (Br. 3-4). Accordingly, we select independent claim 43 as the representative claim on which we shall decide this appeal.

The only difference between the representative rejected claim 43 and the teachings of the applied prior art is that independent claim 43 calls for a film line speed of from about 35 to about 200 feet per minute whereas DeLisio furnishes an example wherein the film line speed is 300 feet per minute (compare independent claim 1 with FF 1-3). Here, the Examiner has reasonably determined that an ordinarily skilled artisan at the time of the

invention would have recognized that the film line speed employed in the Example of DeLisio was a modifiable result effective parameter that an ordinarily skilled artisan would not regard the disclosed casting process to be limited to (Ans. 4; FF 1-3). Hence, the Examiner correctly determined that it would have been prima facie obvious to one of ordinary skill in the art to adjust that parameter to achieve a desirable production speed and product quality through the exercise of routine experimentation and to arrive at a film line speed that fall within the claimed range with a reasonable expectation of success in so doing (Ans. 4-6; FF 1-4).

Appellants do not persuasively refute the obviousness position of the Examiner with their arguments with respect to the lack of description and recognition in DeLisio of both a casting temperature and film line speed for a sPP film making process as claimed by Appellants (Br. 4). In this regard, DeLisio teaches a casting temperature within the claimed casting temperature range for casting sPP film (FF 1). As for the claimed film line speed, we are in complete agreement with the Examiner's obviousness assessment as to this latter claim feature (*id.*). We have no doubt that the level of skill in this art is such (as evidenced by the applied reference and Appellants' acknowledged prior art in the Specification) that reducing the casting film line speed from that used in the Example of DeLisio would have been expected to furnish some benefits, such as better control of the product quality of the film being made. Certainly, such a slower production line speed would have been recognized as an obvious option that an ordinarily skilled artisan would take into account in performing the casting process disclosed by DeLisio to determine workable speeds for different film thicknesses and other desired product characteristics and, in so doing, result

in the arrival at processing line speeds as claimed upon routine experimentation.

As a final point, we observe that evidence of unexpected results or other secondary evidence of non-obviousness is not before us on this appeal record.

CONCLUSION

Appellants have not identified reversible error in the Examiner's obviousness rejection by their arguments, set forth in the Appeal Brief, with respect to the lack of expectation of success of an ordinarily skilled artisan in optimizing the parameters of lines speed and casting temperature for DeLisio's process and, in so doing, arriving at the claimed casting process for making syndiotactic polypropylene film based on the teachings of DeLisio.

ORDER

The decision of the Examiner to reject claims 43, 44, 51-70, and 72 under 35 U.S.C. § 103(a) as being unpatentable over DeLisio is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (2006).

AFFIRMED

ssl/ls

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